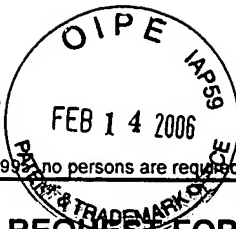


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

15436.436.2

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

Application Number

10/026,016

Filed

12/20/01

First Named Inventor

Johnson

Art Unit

2828

Examiner

NGUYEN, DUNG T

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 50,004

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

David A Jones

Typed or printed name

(801) 533-9800

Telephone number

02/14/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application No. 10/026,016  
Pre-Appeal Brief Request for Review dated February 14, 2006  
Reply to Final Office Action mailed October 14, 2005



**Pre-Appeal Brief Request for Review  
Expedited Procedure  
Examining Group 2828**

EXPRESS MAIL LABEL NO: EV 632 712 335 US

PATENT APPLICATION  
Docket No. 15436.436.2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:		)
		)
	Ralph H. Johnson	)
		)
Serial No.:	10/026,016	) Art Unit
		) 2828
Filed:	December 20, 2001	)
		)
Conf. No.:	6091	)
		)
For:	VERTICAL CAVITY SURFACE EMITTING LASER	)
	INCLUDING INDIUM, ANTIMONY AND	)
	NITROGEN IN THE ACTIVE REGION	)
		)
Examiner:	Dung T. Nguyen	)
		)
Customer No.:	022913	)

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

A succinct, concise and focused set of arguments for which the panel review is being requested begins on page 2.

## **ARGUMENTS**

Reconsideration of the application by a panel of examiners is respectfully requested in view of the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the clear errors and omissions needed for a *prima facie* rejection. In addition, Applicants request that the Panel carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Panel's understanding.

### **II. PRIOR ART REJECTIONS**

#### **B. Rejections Under 35 U.S.C. § 103**

The Patent Office rejects claims 1-27 and 29-34 under 35 U.S.C. § 103(a) as being unpatentable over *Van de Walle et al* (U.S. Pat. No. 5,383,211) in view of *Jewell et al.* (U.S. Pat. No. U.S. Pat. No. 6,359,920). Applicant respectfully traverses this rejection as based on clear error for failure to provide an essential element for a proper *prima facie* case of obviousness.

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (1994); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a prima facie case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142.

It is well recognized that in order to have a valid case of prima facie obviousness, all claim limitations must be taught or suggested (see MPEP §2143). Each of the currently pending independent claims 1, 25, and 33 recite, among other things: "at least one compressed quantum

well.” In direct contrast, *Van de Walle* discloses methods of forming TM-polarized light in the wavelength ranges above 850 nm by adding biaxial tension to the quantum well. Column 3, lines 34-36; column 4, lines 4-26. In other words, the quantum well of *Van de Walle* operates in the tension regime whereas the presently recited claims require operation in the compression regime. The Patent Office has not pointed to where this element is taught, suggested, or made obvious by the prior art. Because all elements of the claims must be addressed and the Patent office has failed to do so the rejection of 1, 25, and 33 is improper and should be withdrawn.

Claims 2-24, 26, 27, 29-32 and 34-37 depend from one of claims 1, 25, or 33. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection of claims 2-24, 26, 27, 29-32 and 34-37 over *Van de Walle* in view of *Jewell* is improper for at least the same reasons as claims 1, 25, or 33.

The Applicants further traverse the motivation for the proposed combination of *Van de Walle* and *Jewell* to reject claims 1-27 and 29-34 and also in the combination of *Van de Walle*, *Jewell*, and *Ramdani* to reject claims 35-37 as clear error.

It is error to reconstruct the Patentee’s claimed invention from the prior art by using the patentee’s claim as a “blueprint.” When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the Applicant’s invention itself.

It is critical to understand the particular results achieved by the new combination. *Interconnect Planning Corp v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of applicant’s specification, to make the necessary changes in the reference device.” *Exparte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added).

The rejections set forth by the Patent Office for obviousness are improper because the Patent Office has not set forth the origin of the motivation for the proposed combination of references. Rather, it appears clear that the rejection is based on impermissible hindsight reconstruction of the Applicant’s invention using the claims as a blueprint as a basis for the

rejection which is improper. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

If the origin of motivation set forth for the proposed combinations is in the references then the Applicants request that this origin be set forth by the Patent Office as required by MPEP 2144.08 III which states, “[w]here applicable, the finding should clearly articulate which portions of the reference support any rejection. Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. *Dillon*, 919 F.2d at 693, 16 USPQ2d at 1901; *In re Mills*, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed. Cir. 1990). Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings.” (Emphasis added).

If the origin of the motivation for the proposed combinations is in the personal knowledge of the Examiner, however, Applicant respectfully requests an Examiner affidavit pursuant to 37 C.F.R. 1.104(d)(2) that: (i) specifically identifies any and all references(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of the claims.

At this point there is no clear factual basis set forth by the Patent Office. Thus, the Applicants respectfully request the Panel to consider whether the Patent Office’s burden has been met to supply a *prima facie* case of obviousness with respect to claims 1-27 and 29-37 prior to Applicants’ submission of the Appeal Brief.

**CONCLUSION**

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 14 day of February, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. A. Jones", with a stylized flourish at the end.

DAVID A. JONES  
Registration No. 50,004  
Attorney for Applicant  
Customer No. 022913  
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